



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,538	02/26/2002	Koji Kunii	450100-03802	2783
20/999 7590 02/17/2009 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				
EXAMINER				
SHEPARD, JUSTIN E				
ART UNIT		PAPER NUMBER		
2424				
MAIL DATE		DELIVERY MODE		
02/17/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/085,538

**Applicant(s)**

KUNII ET AL.

**Examiner**

Justin E. Shepard

**Art Unit**

2424

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

Applicant's arguments filed 11/24/08 have been fully considered but they are not persuasive.

Page 7, section I:

The examiner does not agree with the applicant that paragraphs 134-138 of the published application give support to the newly amended claims. The applicant is invited to indicate to the examiner in the next response how the amendments are supported by these paragraphs.

Page 9, first paragraph:

The applicant argues that the examiner relies on Knudson to teach "that the advertisement information is targeted at a user and targeted at a specific type of portable information terminal apparatus the user is operating." The limitation of targeting information at a specific type of device is a new limitation and has not been rejected by the prior art. Knudson does teach targeting information at a specific user. Figure 16 of Knudson teaches a user setting up preferences for controlling a controllable ticker (column 16, lines 18-41). Figure 24 shows that the controllable ticker can contain an advertisement (column 18, line 61 to column 19, line 28). It's the opinion of the examiner that the user preference setting taught in figure 16 would control the advertisements taught in the controllable ticker shown in figure 24.

Page 10, first paragraph:

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Specifically, the applicant argues that none of the references teach the new limitation of targeting an advertisement at a specific type of device. Bowser discloses a system wherein information is targeted at a specific type of device (column 6, lines 46-54), it is the interpretation of the examiner that as the data is EPG data (column 4, lines 60-63) that the data could include the EPG advertisement data taught by Knudson.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 5, 6, and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added limitation of targeting a specific type of device is not found in the specification.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim refers to a computer program, which does not fit into one of the statutory categories.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowser in view of Newberry in view of Oral in view of Knudson.

Referring to claim 1, Bowser discloses a portable information terminal apparatus comprising:

acquiring means for acquiring a plurality of pieces of program information  
(column 4, line 60);

first display controlling means for controlling display on a display screen of said program information acquired by said acquiring means (column 4, lines 60-63);

wherein the program information comprises information targeted at a specific type of portable information terminal apparatus the user is operating (column 6, lines 46-54);

second display controlling means for controlling display on said display screen of said other program information after retrieval by said retrieving means (column 5, lines 2-6).

Bowser does not disclose an apparatus with extracting means for extracting a time included in said program information; and retrieving means which, based on the time extracted by said extracting means, retrieves other program information about programs to be broadcast in a time slot relative to said program information; and wherein said acquiring means acquires said program information by transmitting through a network, a request including a unique user ID to a provider and acquires said program information applicable to the user ID through said network; and

wherein the other program information comprises advertisement information targeted at a user.

In an analogous art, Newberry teaches an apparatus with extracting means for extracting a time included in said program information; and retrieving means which, based on the time extracted by said extracting means, retrieves other program information about programs to be broadcast in a time slot relative to said program information (column 1, lines 53-57).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the time segment extraction taught by Newberry in the apparatus

disclosed by Bowser. The motivation would have been to provide a small amount of data to the PDA as it has a limit of how much information it can display at one time (Bowser: column 7, lines 18-20).

Bowser and Newberry do not disclose an apparatus wherein said acquiring means acquires said program information by transmitting through a network, a request including a unique user ID to a provider and acquires said program information applicable to the user ID through said network; and

wherein the other program information comprises advertisement information targeted at a user.

In an analogous art, Oral teaches an apparatus wherein said acquiring means acquires said program information by transmitting through a network, a request including a unique user ID to a provider and acquires said program information applicable to the user ID through said network (column 3, lines 48-50, 52-53, and 59-61).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the user specific EPG requesting taught by Oral to the apparatus taught by Bowser and Newberry. The motivation would have been to allow different users to create their own favorite program lists.

Bowser, Newberry and Oral do not disclose an apparatus wherein the other program information comprises advertisement information targeted at a user.

In an analogous art, Knudson teaches an apparatus wherein the other program information comprises advertisement information targeted at a user (figure 16; figure 24; column 18, line 61 to column 19, line 28).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the imbedded advertisement taught by Knudson to the system disclosed by Bowser, Newberry and Oral. The motivation would have been to allow for the EPG information to generate revenue for the distributor, by allowing companies to sponsor the data.

Claims 5, 6, and 7 are rejected on the same grounds as claim 1.

Referring to claim 2, Bowser does not disclose a portable information terminal apparatus according to claim 1, wherein said time is a broadcast start time.

In an analogous art, Newberry teaches a portable information terminal apparatus according to claim 1, wherein said time is a broadcast start time (column 1, lines 53-57; Note: it would be inherent that a time segment would contain beginning and ending times).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the time segment extraction taught by Newberry in the apparatus disclosed by Bowser. The motivation would have been to provide a small amount of data to the PDA as it has a limit of how much information it can display at one time (Bowser: column 7, lines 18-20).



Referring to claim 3, Bowser discloses a portable information terminal apparatus according to claim 1, further comprising third display controlling means which, if any program name is selected by a user performing an operation from among said other program information displayed on said display screen under control of said second display controlling means, then controls display on said display screen of detailed program information about the selected program information (column 7, lines 31-39; Note: the favorite channel creating system is being interpreted as the third display controller).

Referring to claim 4, Bowser discloses a portable information terminal apparatus according to claim wherein, said other program information cannot be displayed entirely at one time on said display screen, then said second display controlling means calls up an un-displayed part of said other program information for display based on an operation performed by a user (column 7, lines 18-20 and 31-32).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/  
Supervisory Patent Examiner, Art  
Unit 2424

JS